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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,580	03/12/2004	Perry A. Cohagan	60655.8000	2579
20322	7590	10/04/2005	EXAMINER	
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 850040001			KIM, AHSHIK	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.		Applicant(s)	
	10/708,580		COHAGAN ET AL.	
	Examiner		Art Unit	
	Ahshik Kim		2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/19/05 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-15 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13-15 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on July 19, 2005. In the amendment
5 claims 2, 12, and 16 were canceled, and claims 1, 3-10, 13-15, 17, and 18 were amended.
Currently, claims 1, 3-11, 13-15, and 17-21 remain for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
10 basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 15 3. Claims 1, 3-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor (US
5,578,808, hereinafter "Taylor").

Re claim 1, Taylor discloses a multi-service card (see abstract) wherein a user can select
a service vendor and perform a desired transaction (see steps 194 thereafter in figure 7) (col. 1,
lines 32+; col. 2, lines 25+). The card not only can hold multiple financial accounts, but can
20 include data such as medical record, insurance information, driver's license or biometric
information (col. 5, lines 42+). The card can also be used as a fair card for mass transit (col. 5,
lines 39-40).

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Re claims 3-4, although not explicitly stated, it is understood that a mass transit includes a bus, subway or train. When the rider's account is debited, it suggests that the vendor's account is credited.

Re claims 5-7, the card also keeps track of bonus/loyalty points such as mileage account which can be redeemed for purchases (col. 5, lines 5-13). It is also known that bonus mileage can be used in purchasing other items or used in car-rentals.

4. Claims 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Fredregill et al. (US 5,923,016, hereinafter "Fredregill").

Fredregill discloses a computer implemented consumer transaction point (loyalty) system (see abstract) wherein a group of retailers in a particular area (see col. 1, lines 15+) participate in the system. Obviously, the same retailers outside designated locations are non-participants. A consumer may earn bonus points in participating store A can go to another participating store B and redeem the points. Accrued points, when redeemed, assumes a monetary value for actual purchases made.

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5. Claims 10, 11, 13, 14, and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Brake, Jr. et al. (US 6,032,136, hereinafter "Brake").

Re claims 10 and 16, Brake discloses a transaction card system wherein the card can be used as a transaction card and also as a credit card (see abstract). The service can be provided by a plurality of service providers (col. 2, lines 43-58). The agreed service providers are in a partner relationship among them. When a card is used both as a transaction card and a credit card, both

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primary party's and the primary party's service partners are provide to the customers (see figure 2; col. 5, lines 30+).

Re claim 11, the card-holder can activate both transaction card and credit card by calling one customer service site (col. 4, lines 62+).

5 Re claim 13, the service provided can be purchasing gasoline or telephone calling time. In the embodiment of gasoline purchase, the bill is sent to the purchaser's address, implying that the gasoline company keeps customer's account.

Re claim 14, the reward points can be earned by purchasing from the partners with consumer's credit (col. 1, lines 29-48; col. 3, lines 12-28)

10 Re claims 18-21, it is the Examiner's view that the methods recited in these claims appear to be generic process of replacing, canceling, or transferring a card account.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
15 obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
20 manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any
25 evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brake, Jr. et al. (US 6,032,136) in view of Fredregill et al. (US 5,923,016)

5 See paragraph 4 above.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brake, Jr. et al. (US 6,032,136) in view of Downing et al. (US 5,963,647).

Brake's teachings have been discussed above. Brake, however, fails to specifically teach or fairly suggest of considering anti-terrorism information when extending credit.

10 Downing teaches a system and the methods for transferring funds (see abstract) In determining approval for transfer, sender's identity is checked for international terrorism identity check (col. 6, lines 48-58).

In view of Downing's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate well-known anti-terrorism check to the teachings of Brake in order to prevent potential terrorist activities involving credit/financial transactions. In approving someone for credit, a basic identity check is performed. In times of increasing terrorism, one ordinary skill in the art would be motivated to screen terrorist activities at root causes if possible. Issuing a credit card, or driver's license without anti-terrorism checking would be a big loophole one should not overlook.

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Response to Arguments

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10. Applicant's amended claims and remarks filed on July 19, 2005 have been carefully reviewed and considered. However, in view of the rejection made above and following grounds, the rejection made in previous Office Action is maintained.

With regards to service partners, There are generally two types of systems: open system
5 and closed system. Regular credit card would be considered a transaction card in open system wherein the card can be used in virtually all retailers and service providers. In open system, the concept of service partners, as recited in the claims partners, is rather weak. Closed system, on the other hand, refers to a system where the card can be used in a specific participants' businesses – a gift card issued by Home Depot®, Target®, Barnes and Noble®, etc. The card is
10 only valid at the designated stores. Obviously the card which can be used at a group of participants business would show the concept of "service partners" well. Taylor, in the Examiner's view is a hybrid system in that the card is used in any establishment where Visa and American Express are received; and it can also be used exclusively at the participating gas companies, hotel chains and airlines, which are service partners.

15 In figures 5, 6A, 6B, 7, and 8, various embodiments of transaction and payment for the transaction is disclosed. Embodiment shown in figure 6A may be interpreted as a transit payment (col. 5, lines 39-40). In Taylor (col. 7, lines 3-45), a description is provided to perform a credit transaction, a debit transaction, and a prepaid transaction. In case of transit which is a prepaid transaction, the steps 162 and 164 would be performed. Taylor (col. 7, lines 17-2) states
20 "..... then at step 162 it is determined whether the financial transaction is prepaid. If so, then the current charge is debited from the account balance at step 164.", suggesting that the transfer of fund to the transit system.

The amended claims and remarks describing these elements have been fully considered, but they are not persuasive, and therefore, the Examiner has made this Office Action final.

Additional references are cited in this Office Action for Applicant's review, which perhaps resemble more to Applicant's embodiment of the presented claims.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
15 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Hogan (US 5,557,516); Park et al. (US 6,705,518); Jun et al. (US 5,828,044); Daggar (US 5,748,737) disclose transaction cards. Applicant is respectfully suggested to review these references.

5 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahshik Kim whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday. The fax number directly to the Examiner is (571)273-2393.

10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

15 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and*
20 *Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Primary Examiner
Art Unit 2876
September 30, 2005